

REMARKS

Claims 1-82 are currently pending. Claims 1-64, 66, 68-70 and 72-82 are withdrawn from consideration as being drawn to a non-elected invention. Claim 65 has been amended to better clarify what Applicants believe to be the invention. No issue of new matter is believed to be introduced by this amendment. If the aforementioned claim amendments are entered, the claims pending will be claims 1-82. Reconsideration of this application is respectfully requested.

Priority Claim

The Examiner alleges that Applicants have not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C 120. In particular, the Examiner notes that an application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (ie. continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

The Examiner alleges that in the present application the application is indicated as being a continuation of the parent application 09/387,418 in the transmittal papers, but the specification was not amended to place the claim for priority into the first sentence as required.

Applicants have amended the specification to include the claim for priority in the first sentence of the specification, thus obviating the Examiner's objection.

Informalities Related to the Specification

The Examiner has objected to the specification because of the following informalities. In particular, the brief description for Figure 4A lacks the required sequence identifiers.

Applicants have amended the brief description of Figure 4A to include the appropriate sequence identifiers, thereby obviating the Examiner's objection.

Rejections under 35 U.S.C. 102(b)

Claims 65, 67, and 71 are rejected under 35 U.S.C. 102(b) as being anticipated by Darnell, *et al.* (WO 96/20954) (Applicant reference AL).

In particular, the Examiner alleges that Darnell, *et al.* teach a Stat 3 protein fragment which comprises amino acid residues 1-514 of Stat 3 fused to the carboxyl terminus of Stat 1 (page 48, lines 29-31). The Examiner further alleges that this fragment comprises residues 107-377 of Stat 3 (SEQ ID NO.: 9) and reads on the elected Stat protein fragment of claim 65 because claim 65 is drawn to "A stat protein fragment selected from the group consisting of...residues 107-377 of Stat 3 (SEQ ID NO.: 9)..." Moreover, the Examiner asserts that in the absence of the Patent Office recognized "closed" language, "consisting of", as it pertains to the residues of the fragment (not the "consisting of that is a part of the Markush group), the fragment is interpreted to be "open", which means that Stat protein fragments that comprise residues 107-377 of Stat 3 (SEQ ID NO.: 9) read on the claimed Stat protein fragment. The Examiner alleges that these residues are within the Stat 3 fragment taught by Darnell, *et al.* (along with additional amino acid residues on both sides), reading on the claimed and elected Stat protein fragment. The Examiner further alleges that the carboxyl terminus that is fused to the Stat 3 fragment reads on an epitope tag because the Stat 1 carboxyl terminus is large enough to constitute an epitope and thus this sequence can act as an epitope tag, such as for purification purposes using antibodies directed against that sequence. Additionally, the reference teaches that the chimeric Stat proteins (which includes the Stat protein fragment comprising amino acid residues 107-377) can be prepared by expressing the protein as a GST fusion (page 34). The Stat 3 protein fragment taught by Darnell, *et al.*, also inherently interacts with c-Jun (105-334 amino acid residues) because it comprises amino acid residues 107-377 of Stat 3, as shown by the instant application, and thus the claim limitations of claim 71 are also met.

Applicants respectfully traverse the Examiner's rejection and have amended claim 65 to recite "consisting of", thereby obviating the Examiner's rejection under 35 U.S.C 102(b). Applicants assert that based on addition of the "closed" language to claim 65, the amino acid residues 107-377 of Stat 3 (SEQ ID NO.: 9) no longer read on the larger fragment of Darnell *et al.* Likewise, Applicants assert that the GST fusion sequence or an epitope tag of claim 67, which is dependent from the stat fragment of currently amended claim 65, no longer reads on the larger fragments of Darnell *et al.* And further, claim 71, drawn to the stat fragment of claim 65, which interacts with c-Jun at residues 1-104 (SEQ ID. NO: 26) or residues 105-334 (SEQ ID NO: 27) no longer reads on the larger fragment of Darnell *et al.* Based on the foregoing claim amendments, withdrawal of the rejection is respectfully requested.

Fees

No fees are believed to be necessitated by the instant response. However, should this be in error, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment, or to credit any overpayments.

Conclusion

Applicants believe that the claim amendments provided herein put the application in condition for allowance. Withdrawal of the rejections is respectfully requested. If a discussion with the undersigned will be of assistance in resolving any remaining issues, the Examiner is invited to telephone the undersigned at (201) 487-5800, ext. 118, to effect a resolution.

Respectfully submitted,



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